

REMARKS/ARGUMENTS

I.

Examiner Winder asked that Applicants file a declaration from a “corporate representative” of the Assignee, Motorola, Inc., explaining that Mr. Krebs’s declaration filed with the original amendment is a declaration of a corroborating witness rather than a declaration from a co-inventor of the subject matter defined by the current claims. In response, submitted herewith as Attachment A is a declaration from Richard Sonnentag, Motorola’s Licensing Counsel, making the required statements.

II.

Examiner Winder noted that page 5 was missing from her file copies of the Eggleston and Hansen declarations submitted on October 23, 2007, and she asked that copies of the complete declarations be re-submitted. In response, submitted herewith as Attachments B and C, respectively, are copies of the complete declarations of Eggleston and Hansen, including page 5 in each case, as submitted on October 23, 2007.

III.

Examiner Winder noted that the screen shots attached to the Eggleston and Hansen declarations submitted on October 23, 2007 were missing from her file copies of those declaration, although one set of them was attached to her Interview Summary Record of the interview held on May 17, 2007, and she asked that copies of the screen shots be attached to the Eggleston and Hansen declarations submitted on October 23, 2007 be re-submitted. In response, those screen shots are attached to the copies of the Eggleston and Hansen declaration submitted on October 23, 2007 submitted herewith as Attachments B and C, respectively.

IV.

Examiner Winder asked Applicants to explain (1) exactly how the screen shots submitted during the interview on May 17, 007 differ from the screen shots submitted on


October 23, 2007 with the declarations of Messrs. Eggleston, Hansen, and Krebs and (2) why the two sets of screenshots differed. In response, new versions of the declarations of Messrs. Eggleston and Hansen (labeled "REPLACEMENT DECLARATION[S]") are submitted herewith as Attachments D and E, respectively. Applicants anticipate submitting a similar declaration from Mr. Krebs shortly.

V.

Examiner Winder stated that, because Applicants' 37 CFR 1.131 declarations had removed Shirakihara as a 35 USC 102(e) reference, she agreed that Applicants' independent claims were now in condition for allowance but for the existence of the interference. However, she pointed out that Applicants' response did not explicitly deal with the rejections based on Shirakihara as they dealt with Applicants' dependent claims. In response, Applicants acknowledge this oversight and thank the Examiner for pointing it out to them. Substantively, they point out that, under case law going back to Judge Rich's seminal opinion in In re Stempel, 241 F.2d 775, 113 USPQ 77 (CCPA 1957), "all the applicant can be required to show [in a 37 CFR 1.131 declaration] is priority with respect to so much of the claimed invention as the reference happens to show." Accordingly, when Applicants antedated Shirakihara (the base reference, cited for the transparency feature), they showed "priority with respect to so much of the claimed invention [i.e., the subject matter recited in the dependent claims] as the reference [i.e., Shirakihara] happens to show."

Respectfully submitted,

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